

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDY M. MANNING
and THOMAS R. FAWCETT, JR.

Appeal No. 1998-0159
Application 08/410,029

ON BRIEF

Before HAIRSTON, BARRETT and HECKER, *Administrative Patent Judges*.

HECKER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 9, all claims pending in this application. The invention relates to a two piece fiber optic ferrule. In particular, with respect to Figure 1,

ferrule capillary 2 has a collar 6 of polygonal cross-section. Noting Figure 5, ferrule capillary 2 is overmolded by base 10. The interference between the collar 6 and the base 10 provides improved torsional and axial strength between the capillary 2 and the base 10 without substantially increasing the size of the fiber optic ferrule.

Independent claim 1 is reproduced as follows:

1. A fiber optic ferrule comprising:

a ferrule capillary having a polygonal collar and a ferrule base retainably engaging said ferrule capillary.

The Examiner relies on the following reference:

Monroe et al. (Monroe)	5,131,063	Jul. 14, 1992
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Claims 1 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Monroe.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

After a careful review of the evidence before us, we will not sustain the rejection of claims 1 through 9 under 35

Appeal No. 1998-0159
Application 08/410,029

U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984)).

The Examiner indicates that Monroe teaches the claimed invention except for the ferrule capillary having a polygonal collar (as recited in claim 1). The Examiner states:

[A] [c]ollar having a [p]olygonal shape is [a] very

elementary teaching in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the polygonal shape collar ferrule in Monroe et al. The ferrule having a collar in [a] different shape is an inherent teaching in the reference. (Final rejection, page 2)

The Examiner further states:

In contrast, [the] Examiner agrees that the '063 patent [Monroe] discloses a ferrule capillary having a cylindrical collar seated within a ferrule base. However, the change i[n] shape from the cylindrical collar to a polygonal collar would be within the level of ordinary skill [of an] artisan, since it has been held that the change i[n] shape would have been obvious to one of [an] ordinary skill[ed] artisan, In re Dailey, 149 USPQ 47 (CCPA 1966). (Answer, page 4)

The Examiner also cites several cases for the concept of what combining references "taken as a whole" would suggest.

First, we are at a loss as to the significance of the citations regarding the combination of references "taken as a whole". The Examiner has not combined references, a single reference is being used.

Second, we see no inherent teaching in Monroe to change a cylindrical collar to a polygonal collar and the Examiner has not referenced any such teaching.

Third, Appellants' disclosure fully discloses the

Appeal No. 1998-0159
Application 08/410,029

claimed polygonal collar, and recites its attribute as
"resisting rotational displacement of the ferrule capillary 2
relative to the ferrule base 10." (Specification, page 5,
lines 13 and 14.)

Accordingly, we find the Examiner has failed to set
forth a ***prima facie*** case.

Appellants argue:

There is no reference in the '063 patent to a possible alternative geometry for the ferrule capillary..... Considerations of alternative capillary geometries and the interaction with the ferrule base are not disclosed nor suggested by the '063 patent. (Brief, page 4)

We totally agree with Appellants. Thus, we will not sustain the rejection of claim 1, and likewise claims 2 through 8 which depend therefrom and include the same unmet polygonal limitation.

With respect to independent claim 9, we note that the polygonal collar of claim 1 is not recited. Instead, a collar "having at least one flat side thereon" is recited. Although neither the Examiner nor Appellants have commented on this broader rendition of the invention, we find the Examiner has similarly failed to state a ***prima facie*** case for the rejection. That being the case, Appellants' lack of rebuttal is moot, and we will not sustain the rejection of claim 9.¹

At page 5 of their brief Appellants discuss the

¹We also note that the drawings do not illustrate the claim 9 variation, nor is there any language in the specification indicating other than a polygonal shape.

relevance of the '183 patent (U.S. Patent No. 5,375,183). The Examiner is correct that this patent is irrelevant because it was not cited as part of the rejection. However, since Appellants have seen fit to compare '183 to the claimed invention, we feel it in order to note our own observations. Ribs 40 of '183 accomplish the same resistance to rotational displacement as Appellants' polygonal shape. Although there are differences between the two, we note these differences to be akin to changing from a Phillips head tool to an Allen head tool for improvement in rotational resistance. We note also that '183 teaches overmold to resist axial forces, as in the instant invention. Furthermore, regarding claim 9, we note that "at least one flat side thereon" is akin to the rotational resistance provided by the common knob placed on a shaft, be it a kitchen stove, electronic equipment, or other appliance.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In***

Appeal No. 1998-0159
Application 08/410,029

re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." **Para-Ordinance Mfg. v. SGS Importers Int'l**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

As pointed out above, the Examiner has not proffered a viable motivation for obtaining Appellants' polygonal shape or at least one flat side. Since there is no evidence in the record that the prior art suggested the desirability of such a modification, we will not sustain the Examiner's rejection of claims 1 through 9.

Appeal No. 1998-0159
Application 08/410,029

We have not sustained the rejection of claims 1 through 9 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

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KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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STUART. N. HECKER)	
Administrative Patent Judge)	

Appeal No. 1998-0159
Application 08/410,029

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